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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/626,811	07/27/2000	Kotaro Oami	5000-4777	9671

7590

01/17/2002

Alfred L Haffner Jr  
Morgan & Finnegan LLP  
345 Park Avenue  
New York, NY 10154

EXAMINER

RHEE, JANE J

ART UNIT

PAPER NUMBER

1772

5

DATE MAILED: 01/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-5

<b>Office Action Summary</b>	Application No. 09/626,811	Applicant(s) OAMI ET AL.	
	Examiner Jane J Rhee	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 7-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: ____                                     |

**DETAILED ACTION**

***Election/Restrictions***

1. Claims 1-6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected groups I and II, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 4.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 is vague and indefinite therefore rejected because it is a non-elected claim. Claim 7 limitation should have been inserted into claim 7.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katsumi in view of Nishio et al (6103999).

As to claim 7, Katsumi discloses an insert film (figure 3 number 7, 13, 14) used to form a resin panel (figure 3 number 2 and 8) having a print (abstract line 8) therein by arranging the film on a surface of a resin panel body, the insert film comprising a resin film (figure 3 number 7), a first binder layer formed on the surface of the resin film (figure 3 number 13); a printed part, and a second layer (figure 3 number 14). Katsumi discloses a resin panel comprising the insert film described above and a resin panel body integrally molded with the insert molding in a state such that a surface of the resin film of the insert film at the side on which a printed part is formed faces inside (abstract and figure 3). Katsumi fails to disclose that the printed part formed on the first binder layer and a second binder layer formed so as to seal the printed part in co-operation with first binder layer.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the printed part formed on the first binder layer and a second layer formed so as to seal the printed part in co-operation with the first binder layer, since it has been held that rearranging parts of an invention involves only routine skill in the art absence of showing unexpected results. In re Japikse, 86 USPQ 70.

As to claim 8 and 9, Katsumi et al. discloses the resin panel described above wherein the second binder layer covers the periphery of the first binder layer to directly adhere closely to the resin film (see figure 3 number 7, 13, 14). Katsumi fails to disclose that the resin panel body is directly adhered closely to the resin film at an outer side of the periphery of the first binder layer or on an outer side of the periphery of the

second binder layer. However, Nishio et al. teaches the resin body being directly adhered closely to the resin film for the purpose of a stronger adhesion (col. 1 line 63).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have provided Katsumi with a resin body that is directly adhered closely to the resin film in order to have a stronger adhesion (col. 1 line 63) taught by Nishio et al. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the resin panel body directly adhere closely to the resin film at an outer side of the periphery of the first binder layer, since it has been held that rearranging parts of an invention involves only routine skill in the art absence of showing unexpected results. In re Japikse, 86 USPQ 70.

As to claim 12, Katsumi et al fails to disclose that the resin panel is a window for automobiles, the material of the resin panel body is the same as the resin film, and that the material of the resin panel body and the resin film is polycarbonate. However, Nishio et al. teaches that the resin panel is a window for automobiles (col. 1 line 32), the material of resin panel body is the same as the resin and that the material of the resin panel body and the resin film is polycarbonate (col. 4 line 42) for the purpose of excellent adhesion between the resin panel and resin film (col. 6 line 14).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have provided Katsumi et al. with a resin panel that is used for automobile windows, the same material for both the resin panel and the resin film and that the material of the resin panel body and the resin film is polycarbonate in order to

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have excellent adhesion between the resin panel and resin film (col. 6 line 14) taught by Nishio et al.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-301-9999 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Jane Rhee  
January 9, 2002

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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1/9/02